

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-9, 14, and 15 are pending in this case.

In the outstanding Office Action Claims 1 and 6-9, 14, and 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Iida (U.S. Patent No. 6,952,279) in view of Shibata (U.S. Patent No. 6,825,955); Claim 2 was rejected under 35 U.S.C. § 103(a) as unpatentable over Iida in view of Shibata, further in view of Saga (U.S. Patent No. 6,873,841); Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as unpatentable over Iida in view of Shibata, further in view of Otsuka et al. (U.S. Patent No. 6,700,674, herein “Otsuka”); and Claim 5 was rejected under 35 U.S.C. § 103(a) as unpatentable over Iida in view of Shibata, further in view of Sato (U.S. Patent No. 6,230,189).

Applicant respectfully traverses the rejections of the pending claims.

Claim 1 is directed to a facsimile apparatus and includes:

- a system control unit which controls an operation of the facsimile apparatus;
- a communication management unit which stores communication management information in response to occurrence of a facsimile communication;
- an address registration unit which registers an email address to which email is transmitted; and
- a data-format conversion unit which **converts the communication management information stored in said communication management unit into data in a text format,** wherein said system control unit sends the communication management information in the text format to the email address registered in said address registration unit by email **when a number of facsimile transmissions to a specified address exceeds a predetermined number.**

The outstanding Office Action asserts Iida as teaching every element of Claim 1 except “when a number of facsimile transmissions to a specified address exceeds a

predetermined number,” as recited by claim 1. Specifically, the outstanding Office Action asserts the TIFF conversion section 14 of Iida as teaching a data-format conversion unit as defined by Claim 1. Further, the outstanding Office Action asserts the E-mail service unit 16a of Shibata as teaching the above-highlighted portion of the system control unit, as defined by Claim 1.

Iida does not teach or suggest a data-format conversion unit, as defined by Claim 1. As described at column 4, lines 15-20, of Iida, the TIFF conversion section 14 converts **coded facsimile data and document file data** into the TIFF format. However, the TIFF conversion section 14 of Iida does not teach or suggest a conversion unit “which **converts the communication management information stored in said communication management unit into data in a text format,**” as recited by Claim 1.

Also, Iida fails to teach or suggest “said system control unit sends the communication management information in the text format,” as recited by Claim 1, because Iida fails to teach or suggest conversion of communication management information, as discussed above.

Even if, *arguendo*, Iida taught the features of Claim 1 that it is asserted to teach, which it clearly does not, Shibata does not cure the deficiency of Iida with regard to Claim 1 that is conceded, at page 4, by the outstanding Office Action.

Shibata describes, at column 14, lines 1-52, that, when a call is received with an E-mail transmission notice but the incoming E-mail is determined not to be stored in the Internet server 7 upon checking for more than a number of access times, the third E-mail service unit 18a sends an E-mail receiving error notice.

However, Shibata’s description of a **number of accesses to the Internet server 7** to look for an incoming E-mail **exceeding a predetermined value** does not teach or suggest “a **number of facsimile transmissions to a specified address exceeds a predetermined number,**” as recited by Claim 1.

Even assuming, *arguendo*, that Iida teaches every element of Claim 1 except the above-discussed feature and that Shibata cures the deficiency of Iida, although, as discussed above, neither reference teaches all the features it is asserted to teach, the asserted combination itself is not even proper.

When a combination of references is asserted as teaching every element of a claim, both the asserted modification, or how the references are combined, as well as the asserted motivation for the combination, or why one of ordinary skill in the art would combine the references, must be specified in the rejection. MPEP § 706.02(V) sets out the requirement for asserting the modification. As to the asserted motivation, the Court recently reiterated the requirement of MPEP § 2143.01 by stating that a “patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” KSR Int. Co. v. Teleflex Inc., 82 USPQ2d 1385, 1389 (2007). The Court stated the importance of identifying “a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.” *Id.*

In this case, the outstanding Office Action proposes, at page 4, “to modify the system of Iida as taught by Shibata to include: a number of facsimile transmissions to a specified address exceeds a predetermined number, since Shibata stated...that such a modification would ensure a unique communications apparatus has been developed recently.” Applicant finds both the statement regarding the modification and the statement regarding the motivation for the modification to be confusing.

The outstanding Office Action asserts, at page 3, that the CPU 1 of Iida teaches a system control unit as defined by Claim 1 and that the coded facsimile data and document file data of Iida teaches communication management information as defined by Claim 1. Thus, the proposed modification would add a condition to when the CPU 1 of Iida sends the coded facsimile data and document file data. That condition, as described in Shibata, relates to

whether a received E-mail is in the Internet server 7. Making the transmission of coded facsimile data and document file data by the CPU 1 of Iida conditional on the number of times the Internet server 7 is checked for an incoming E-mail not only represents an improper combination under MPEP § 2143.01(VI) because it changes the principle of operation of Iida but also fails to teach or suggest the elements of Claim 1 that the combination of references is asserted to teach.

Because the combination of Iida and Shibata, which itself is not proper, does not even teach or suggest every element of Claim 1, Applicant respectfully requests that the rejection of Claim 1 under 35 U.S.C. § 103(a) be withdrawn.

Claims 14 and 15, though differing in scope from Claim 1, patentably define over Iida and Shibata for similar reasons as Claim 1.

Further, although Iida and Shibata are asserted against Claims 14 and 15, the outstanding Office Action does not address the recitation of “**when a number of facsimile transmissions during specified hours exceeds a predetermined number**” in Claim 14 and “**when a number of facsimile transmissions longer than a specified communication time exceeds a predetermined number**” in Claim 15 at all but, rather, repeats the recitation and rejection of Claim 1. The highlighted features of Claims 14 and 15 are clearly not taught or suggested by Shibata’s description of determining if the number of times that the Internet server 7 is accessed to look for an incoming E-mail exceeds a predetermined value.

Accordingly, Applicant respectfully requests that the rejection of Claims 14 and 15 under 35 U.S.C. § 103(a) be withdrawn.

Claims 2-9 depend from Claim 1 and, therefore, patentably define over Iida and Shibata for at least the same reasons as Claim 1. Further, Saga, Otsuka, and Sato, which are additionally asserted against Claims 2-5, do not cure the deficiencies of Iida and Shibata,

discussed above, with regard to Claim 1. Thus, Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) of Claims 2-9 be withdrawn.

Consequently, in light of the above discussion, the present application is in condition for formal allowance and an early and favorable action to that effect is requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Usha Munukutla-Parker
Registration No. 61,939

Customer Number

22850

Tel: (703) 413-3000

Fax: (703) 413-2220

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